

## **REMARKS/ARGUMENTS**

Claims 1, 3, 4, 14, 16, 18, 20, 21, 27, 37 and 38 are pending in the present application and remain in this application for prosecution. Claims 1, 14, 18, 27, and 37 (which are the only independent claims) have been amended. Claims 28-36 and 39 (previously withdrawn) have been cancelled.

Claims 1, 14, 18, and 27 have been rejected under 35 U.S.C. § 103(a) (“§ 103”) as being unpatentable over U.S. Publication No. 2002/0093136 to Moody (“Moody”) in view of U.S. Patent No. 5,851,148 to Brune et al. (“Brune”) and U.S. Publication No. 2003/0036427 to Brandstetter et al. (“Brandstetter”). Claims 3, 4, 16, 20, and 21 have been rejected under § 103 as being unpatentable over Moody in view of Brandstetter as applied to claims 1, 14, and 18, and further in view of U.S. Publication No. 2003/0100362 to Horniak et al. (“Horniak”). Claims 37 and 38 have been rejected under § 103 as being unpatentable over Moody in view of Brune, Brandstetter, and U.S. Publication No. 2001/0039513 to Erlichson et al. (“Erlichson”).

### **Examiner Interview**

The Applicant notes with appreciation a telephone conference conducted on October 13, 2005 with Examiners Coburn Corbett and Alex Rada. Although no agreement was reached, the Applicant is appreciative of the Examiners’ comments. The telephone conference is addressed below, in more detail.

### **§ 103 Rejections**

**Claims 1, 14, 18, 27, and 37** have been rejected as being unpatentable over a combination of references including Moody and Brune. The Examiner has acknowledged that “Moody does not expressly disclose . . . [a] predetermined triggering condition being based on . . . time of day.” But the Examiner has alleged that Brune teaches a “predetermined triggering condition being based on at least one of a number of game plays, a frequency of play, . . . time of day as recited in claims 1, 14, 18, and 27.”

Claims 1, 14, 27, and 37, as amended, are each directed to “dispensing a tangible sweepstakes entry form from the gaming machine in response to a predetermined triggering condition” based on “a time of day.” Claim 18, as amended, is directed to “dispensing a tangible

sweepstakes entry form in response to a predetermined triggering condition” being based on “a time of day.”

Nowhere does Brune teach a predetermined triggering condition, for triggering a tangible sweepstakes entry form, being based on “time of day.” In fact, during the telephone conference, the Examiner acquiesced that Brune does not teach a “predetermined triggering condition being based on . . . time of day.”

Nevertheless, during the telephone conference, the Examiner argued that a “time of day” triggering condition would be obvious in view of Brune’s teaching of a trigger event being based on a “number of games” and in view of the current disclosure describing a triggering event being based on a “game outcome, a number of plays of the game, . . . time of day, or some other criteria.” In the Examiner’s words, a person of ordinary skill in the art is entitled to treat as equivalents the “number of games” trigger event (taught by Brune) and, the “time of day” triggering condition (claimed in the current application) because the current application provides a list of triggering events that includes a “number of plays of the game” and a “time of day.” Thus, the Examiner’s logic is that the claim element “time of day” is obvious in view of the phrase “number of games” because i) Brune teaches the phrase “number of games” and ii) the current application “admits equivalence” to the “number of plays of the game” and the “time of day” by listing them together as alternative triggering conditions.

The Examiner’s logic is incorrect for at least two reasons: a) the claimed inventions as a whole must be considered, and b) impermissible hindsight.

A. “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the difference themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” Manual of Patent Examining Procedure (“MPEP”), Eighth Edition, Incorporating Revision No. 2, May 2004, § 2141.02, pages 2100-124, 125. The Examiner is improperly considering whether the difference between the two different triggering conditions (the “number of games” trigger event taught by Brune and the “time of day” triggering condition claimed in the current application) would have been obvious. However, the Examiner fails to consider the claimed invention as a whole. For example, Brune has nothing to do with sweepstakes entry forms, wherein claims 1, 14, 18, 27, and 37 are each directed to the dispensing of a “tangible sweepstakes entry form.” Clearly, one

of ordinary skill in the art would not look to Brune, which does not teach anything whatsoever about sweepstakes entry forms,” to learn about a “number of games” trigger event for finding a solution that results in a “time of day” triggering condition.

B. Any reliance on the Applicants’ disclosure to support the rejection is improper. “It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992) (*see also In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) *stating* “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant’s disclosure.”). Thus, any judgment on obviousness is proper “so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant’s disclosure.” *Id.*, § 2145 (X)(A), page 2100-161 (emphasis added). Based on the Examiner’s logic, the skilled artisan must use the disclosure of the current application to derive the “time of day” triggering condition from the “number of games” trigger event. As stated by the Federal Circuit Court of Appeals and by the MPEP, this is clearly improper.

Thus, claims 1, 14, 18, 27, and 37, along with all the claims dependent thereon, are patentable over any combination of references including Brune for at least the above-identified applicable reasons.

**Claim 38** was rejected on a combination of references that includes Erlichson. Specifically, the Examiner has alleged that Erlichson teaches “allowing access to the website (figures 1-4) as recited in claims 37 and 38.”

Claim 38 is directed to a “security access code” for allowing access to the website. **Nowhere** in the final Office Action is this element of claim 38 -- “security access code” -- mentioned as being disclosed by the cited references. In fact, the element “security access code” is mentioned only when acknowledging that “Moody does not expressly disclose . . . a security access code . . . .”

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior

art”. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970); *see also In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (*stating* “[w]hen evaluating the scope of a claim, every limitation in the claim must be considered”). For claim 38, the final Office Action fails to address all the specific elements set forth in the claim. In short, the Applicants are left guessing at what the Examiner’s position may, or may not, be with respect to claim 38. As such, it is impossible for the Examiner to have established a *prima facie* case of obviousness. Therefore, the Examiner has failed to discharge his burden of proof with regard to the obviousness rejection of claim 38. More importantly, none of the cited references (including Erlichson) teaches having a “security access code” for allowing access to a website.

Thus, claim 38 is not obvious in view of the cited references (including Erlichson) at least for the above-identified applicable reasons.


### Conclusion

It is the Applicant's belief that all the pending claims are now in condition for allowance, and thus reconsideration of this application is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

It is believed that no fees are due; however, should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Jenkins & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 47079-00117USPT.

Respectfully submitted,

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